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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,736	09/06/2000	Chung-Ching Michael Wang	12192RR (NORTH 1967001)	9034
21909	7590	04/28/2004	EXAMINER	
CARR LAW FIRM, L.L.P. 670 FOUNDERS SQUARE 900 JACKSON STREET DALLAS, TX 75202			FERRIS, DERRICK W	
			ART UNIT	PAPER NUMBER
			2663	

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/655,736

Applicant(s)

WANG ET AL.

Examiner

Derrick W. Ferris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. **Claims 1-31** as amended are still in consideration for this application. Applicant has amended claims **1, 7, 8, 14, 15, 22, and 27**.
2. Examiner **withdraws** the obviousness rejection to *Brown* in view of *Sexton* in further view of *Noneman* and *Brown* in view of *Sexton* in further view of *Noneman* and *Boulos* for Office action filed 12/24/03. Below please find a new rejection for the claims as necessitated by amendment. In summary, examiner doesn't consider a reservation field reserved for future use of a particular length, such as less than five bits, a novel feature in view of the prior art.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 3, 4, 7, 8, 10, 11, and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,363,242 B1 to *Brown, Jr. et al.* ("*Brown*") in view of U.S. Patent No. 6,614,772 B1 to *Sexton et al.* ("*Sexton*") in further view of U.S. Patent No. 5,887,252 A to *Noneman* and U.S. Patent No. 5,963,548 to *Virtanen*.

As to **claim 1**, *Brown* discloses identifying alternative service options. In particular, *Brown* discloses using an alternative service option since the standard 16-bit service option (i.e., in reference to the term service option recited in the claims) may potentially waste excess bits since not all bits in the 16-bit field are used. For the purpose

of the rejection, examiner thus notes two possible interpretations that read on the claims with respect to *Brown*. The first interpretation is with respect to the “preferred” service option and the second interpretation is with respect to an alternative service option. With respect to a “preferred” service option a SPECIAL_SERVICE field (i.e., a service option omit field) determines if the SERVICE_OPTION field is 0 or 16 bits (i.e., see column 2, lines 25-45) (i.e., as a supplementary reference see column 4, lines 21-50 of *Noneman* with respect to a SPECIAL_SERVICE field as is known in the art). A REQUEST_MODE also serves as a reasonable but broad interpretation of a “service reference identifier”. With respect to the alternative service option, a NUM_ALT_SO field (i.e., a service option omit field) determines whether an ALT_SO_GROUP field is present (e.g., see column 3, lines 25-32).

Brown is silent or deficient to the further limitation of a short data burst. In particular, *Brown* discloses an origination or page response message for both CDMA 2000 and IS-95B (e.g., see column 2, lines 14-18).

Sexton teaches the further limitation of a short data burst (e.g., see column 3, lines 27-39).

Examiner notes that it would have been obvious to one skilled in the art prior to applicant’s invention to include short data bursts to transmit information when operating in an intermediate state such as origination or page response messages. In particular, one skilled in the art would be motivated to modify the teachings of *Brown* to include a short data burst as part of an origination or page response message since both references teach IS-95 and CDMA in general and messaging in particular where messages are sent when

the mobile station is operated in an intermediate state in addition to the active and dormant state. The suggestion or motivation for doing so would have been to maximize system performance. In particular, *Sexton* cures the above-cited deficiency by providing a motivation found at column 3, lines 20-39.

In addition, *Brown*, *Sexton* and *Noneman* may be silent or deficient to the further limitation “a reserve field that is at least reserved for future use, wherein the reserved field is less than five bits long”. In particular, these references disclose fields that are reserved but may be silent as to fields that are reserved for a future use.

Virtanen teaches the above-mentioned limitation at e.g., column 12, line 31; column 13, line 17; column 17, line 25; and column 14, lines 60-64.

Thus examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the further limitation of a reserve field that is at least reserved for future use, wherein the reserved field is less than five bits long. In particular, *Virtanen* discloses a variable length reservation field that is capable of being less than 5 bits long. Thus the limitation is met. Examiner also notes a broad but reasonable interpretation of “for future use”. As such, *Virtanen* discloses a motivation for using a reservation field in order make the length of the entire message equal to an integer number of octets. In particular, as shown in tables, these reserved fields are not reserved for anything in particular, thus meeting a reasonable but broad interpretation of “for future use”. Examiner would like to point out that missing from applicant's invention is a clear definition of “future use” e.g., see applicant's specification at page 5, lines 7-8. As such, examiner notes a reasonable but broad interpretation of the recited

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claimed subject matter. Examiner notes a reasonable expectation of success since *Virtanen* discloses a reservation field for a short data burst for CDMA.

As to **claim 3**, see e.g., column 2, lines 20-22.

As to **claim 4**, see e.g., column 2, lines 20-22 (e.g., the mobile or network defines the parameters).

As to **claims 7 and 8**, see the rejection for claim 1.

As to **claim 10**, see the rejection for claim 3.

As to **claim 11**, see the rejection for claim 4.

As to **claim 14**, see the rejection for claim 1.

5. **Claims 2, 5, 6, 9, 12, 13 and 15-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,363,242 B1 to *Brown, Jr. et al.* ("*Brown*") in view of U.S. Patent No. 6,614,772 B1 to *Sexton et al.* ("*Sexton*") in further view of U.S. Patent No. 5,887,252 A to *Noneman*, U.S. Patent No. 5,963,548 to *Virtanen* and U.S. Patent No. 6,208,634 B1 to *Boulos et al.* ("*Boulos*").

As to **claim 2**, *Brown* discloses sending an originating message from a mobile and not necessarily a base station. In particular, *Brown* does disclose sending messages from a base station as extended system parameters message but is silent to a SERVICE_OPTION (e.g., see column 4, lines 50-67). Thus *Brown* is silent or deficient to the further limitation wherein the steps are performed by the base station.

Boulos teaches the further limitation wherein the steps are performed by the base station. In particular, *Boulos* teaches performing the steps at either a mobile station or base station (e.g., see column 3, lines 20-28).

Examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include wherein the steps are performed by the base station. In particular, one skilled in the art would be motivated to perform the steps at either the base station or the mobile since both may require service options. The suggestion or motivation for doing so would have been that both references support IS-95 in general for CDMA and in particular an originating and page response message. In particular, *Boulos* cures the above-cited deficiency by providing a motivation found at column 3, lines 20-36 and column 4, lines 18-48).

As to **claim 5**, in addition to the rejection to claim 2 with respect to the further limitation "transmitted to the mobile station" an origination message is a reasonable but broad interpretation of a non-negotiable service configuration record (e.g., see column 2, lines 18-64).

As to **claim 6**, in addition to the rejection to claim 2, see a P_REV_IN_USE field taught by *Brown* with respect to an alternative service option (e.g., see column 3, lines 26-34 of *Brown*).

As to **claim 9**, see the rejection for claim 2.

As to **claim 12**, see the rejection for claim 5.

As to **claim 13**, see the rejection for claim 6.

As to **claims 15-16**, in addition to the rejection to claim 1, *Brown* may be silent or deficient to the physical/software implementation on how the method is implemented. Examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to perform the physical/software implementation using a

microprocessor and computer program code. In particular, one skilled in the art would be motivated to perform the software implementation of a microprocessor as part of a design decision. As such, *Boulos* further teaches a microprocessor at both a mobile and base station where one skilled in the art would recognize that instructions are executed using computer program code. Thus *Boulos* cures the above-cited deficiency by disclosing that the method as taught by *Brown* can be implemented as computer program code on a processor (e.g., processor 30 or 40 as shown in figure 1 of *Boulos*).

As to **claim 17**, see the rejection for claim 2.

As to **claim 18**, see the rejection for claim 3.

As to **claim 19**, see the rejection for claim 4.

As to **claim 20**, see the rejection for claim 5.

As to **claim 21**, see the rejection for claim 6.

As to **claims 22-23**, see the rejection for claims 15-16.

As to **claim 24**, see the rejection for claim 4.

As to **claim 25**, see the rejection for claim 5.

As to **claim 26**, see the rejection for claim 6.

As to **claims 27-28**, see the rejection for claims 15-16.

As to **claim 29**, see the rejection for claim 4.

As to **claim 30**, see the rejection for claim 5.

As to **claim 31**, see the rejection for claim 6.

Conclusion

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6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick W. Ferris
Examiner
Art Unit 2663


DWF


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TECHNOLOGY CENTER 2600 4/26/08